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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,466	03/09/2001	Paul D. Taylor	P-408	7041

7590 12/23/2005

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EXAMINER

MARVICH, MARIA

ART UNIT	PAPER NUMBER
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1633

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/802,466	Applicant(s) TAYLOR ET AL.	
Examiner Maria B. Marvich, PhD	Art Unit 1633	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2, 4, 6-11, 21 and 26-28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claims 1, 2, 4, 6-11, 21 and 26-28 as being anticipated by Gjerde et al in view of Bloch et al as Gjerde and the instant invention are commonly assigned.

Applicants traverse the rejection under 35 USC 103 as being anticipated by Oefner et al in view of Bloch et al as well as those rejected further in view of Petro et al and further in view of Sheridan and Sheridan. Applicants argue that the combination of the references lacks motivation for their combination. Furthermore, applicants argue that neither Oefner nor Bloch et al teach or suggest that column diameter is a result-effective variable, a deficiency which neither Petro et al or Sheridan and Sheridan cure. Applicant point to MPEP 2144.05.

Applicants arguments filed 11/23/05 have been fully considered but they are not persuasive. The MPEP states that "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In the instant case, the nature of the problem to be solved by Oefner and Bloch methods of separating nucleic acids, are the same. Hence a person of skill in the art would have looked to the teachings of Bloch et al to "discover optimum or workable condition ranges". To this end, Bloch et al demonstrate that column size is a result-effective variable. Specifically in column 17, line 20, Bloch et al teach, "The most important component of the HPLC equipment is the column and its packing." The MPEP teaches (2143.01), "The court stated that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." The court emphasized that the proper inquiry is "whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination," not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available." Bloch et al do not teach only that the column should be no more than 5 mm but teaches that the column will not exceed 50 mm and may be as short as 10 mm. Therefore, Bloch et al by teaching alternatives does not teach away from a specific size but in fact teaches the desirability of varying columns size such as to greater than 5 mm and as such provide the motivation to combine the references. As to MPEP 2144.05, it is not clear as to why applicants indicate this teachings as the teachings appear to indicate that "prior art suggested that a larger number of elongated grips in the weight plates was beneficial... thus plainly suggesting that one skilled in the art look to the range appearing in the prior art." This passage suggests that motivation to combine ranges from the prior art is inherent in the fact that the art is teaching ranges. As Bloch et al teach and provide the motivation to use columns that are greater than 5 mm, neither Petro et al or Sheridan and Sheridan need provide these teachings.



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